REMARKS

Rejection Under 35 U.S.C. §102(e)

Claims 73-75, 85, 95-96, and 100 stand rejected under 35 U.S.C. §102(e) as anticipated by Smith (U.S. Patent No. 5.945,579). The applicants argued that Smith is not enabling, but the Office refused to consider this argument, asserting that it is not within an Examiner's purview to evaluate the validity of the claims of a granted U.S. patent. The Applicants respectfully submit that the Examiner need not opine on the validity of the Smith patent to find that it is not enabled with respect to transgenic poinsettia, and, therefore, it is not outside the Office's purview to find that Smith does not anticipate the presently claimed invention.

It is true that a granted patent is presumed to be valid, and the Applicants do not argue with this premise. However, it is well settled that the claims of an invention will not be considered invalid, "even if some of the claimed combinations [are] inoperative." *Atlas Powder Co. v. E.I. DuPont de Nemours & Co.*, 750 F.2d 1569, 1576-77 (Fed. Cir. 1984). It is only "if the number of inoperative combinations becomes significant, and in effect forces one of ordinary skill in the art to experiment unduly in order to practice the claimed invention" that the claims might be invalid." *Id.* It necessarily follows, therefore, that the specification need not enable each and every embodiment encompassed within the scope of the claims to support the claims' validity.

In view of the foregoing, the applicants respectfully submit that the Patent Office may find that a single claimed embodiment of the Smith patent (*i.e.*, transgenic poinsettia) is not enabled without also finding or implying that the corresponding Smith claim is invalid.

The Smith patent makes reference only twice to transgenic poinsettia plants in the specification (at Column 7, line 24) and in Claim 11. As Applicants have previously noted, Smith merely lists species of plants for which they expect the patented transformation will work: "It is fully **expected**, as in the case of tobacco employed by way of example herein, that transgenic plants expressing the proximity-conditional dwarfing phenotype produced according to the methods of the present invention will stably and reproducibly transmit this trait to their progeny through their seeds." Smith at Column 11, Lines 18-23. However, Smith merely provides a single example of an operative embodiment:

tobacco. As noted in a previous Response, the mere mention of poinsettia is insufficient to demonstrate enablement. *Elan Pharmaceuticals, Inc. v. May Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054 (Fed. Cir. 2003). ("The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; **mere naming or description of the subject matter is insufficient.**" (emphasis added)).

The Applicants have demonstrated that prior to their invention transformation of poinsettia with a foreign gene had not been successfully performed. See, for example, Preil, "In Vitro Culture of Poinsettia," in THE SIENTIFIC BASIS OF POINSETTIA PRODUCTION, Stramme (ed), pages 49-56 (The Agricultural University of Norway 1994), Specification, p. 9, ll. 31-38. As noted in previous responses to office actions, at the time of filing of the present application the Applicants were the only ones to have successfully transformed poinsettia plants, and the methods employed by the applicants are not described in Smith. More significantly, Smith provides absolutely no teachings specific for transformation of poinsettia and, therefore, fails to compensate for the known deficit of the prior art vis-à-vis enablement of transgenic poinsettia.

In view of the foregoing, therefore, the applicants respectfully submit that (a) the Office may consider whether Smith enables transgenic poinsettias without such consideration implying anything about the validity of the Smith patent, and (b) the Smith patent does not enable transgenic poinsettias. Consequently, the present claims cannot be anticipated by Smith. The applicants respectfully request reconsideration and withdrawal of this rejection.

Rejection Under 35 U.S.C. §103(a)

Claims 73-96, and 100, and 112 stand rejected under 35 U.S.C. §103(a) obvious over Smith, the same reference as applied for the §102(e) rejection, above. As described below, the Applicants respectfully traverse.

Smith fails to render the present claims obvious because of the very same deficiencies discussed above. Namely, Smith is not an enabling reference for the presently claimed invention. While it is true that a reference need not be enabling to be used for an obviousness rejection, the Applicants respectfully contend that, as Smith is not enabling, one of ordinary skill in the art could not have a

reasonable expectation of success making a transgenic poinsettia plant based on Smith's teachings. Not until the filing of the present application was a method made available to make transgenic poinsettia with a reasonable expectation of success. Without a reasonable expectation of success, the presently claimed transgenic poinsettia cannot be obvious. Accordingly, the Applicants respectfully request reconsideration and withdrawal of this rejection.

In view of the foregoing remarks, the Applicants believe the pending claims are in condition for allowance. If there are any questions or comments regarding this Response or this Application, the Examiner is encouraged to contact the undersigned attorney.

Respectfully submitted,

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Michael S. Greenfield
Registration Number 37,142

McDonnell Boehnen Hulbert & Berghoff LLP
300 South Wacker Drive
Chicago, IL 60606

Telephone: 312-913-0001
Facsimile: 312-913-0002